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Paper No. 15
AD

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Gail Rosen/Steve Rosen

Serial No. 75/606,813

Erin Williams of Intellectual Property Law Group LLP for
Gail Rosen/Steve Rosen.

Golnaz Gharib, Trademark Examining Attorney, Law Office 113
(Meryl Hershkowitz, Managing Attorney).

Before Cissel, Hanak and Drost, Administrative Trademark
Judges.

Opinion by Drost, Administrative Trademark Judge:

On December 16, 1998, Gail Rosen/Steve Rosen
(applicant), identified as a general partnership, filed an
application to register the mark MICRO SHAPES (in typed
form) for goods identified as "eyeglasses, eyeglass frames
and sunglasses" in International Class 9.¹ The application
alleges a date of first use of January 1997 and a date of

¹ Serial No. 75/606,813.

first use in commerce of March 1997. The application also contains a disclaimer of the word "shapes."

The Examining Attorney² finally refused to register the mark under Section 2(d) of the Trademark Act because of a registration of the mark SHAPES (in typed form) for "sunglasses, sunglass cases, sunglass straps, lenses and parts for sunglasses" in International Class 9.³ 15 U.S.C. § 1052(d). The Examining Attorney determined that there would be a likelihood of confusion when the marks MICRO SHAPES and SHAPES were used on the identified goods.

After the Examining Attorney made the refusal final, this appeal followed. Both applicant and the Examining Attorney filed briefs. An oral hearing was not requested.

The Examining Attorney's position is that the goods are identical and competitive products and the marks are highly similar. Applicant submits that its goods are expensive, sold in high end optical and optometry stores, and are "prescription eyewear (frames) and clip-on sunglass-type lenses for use only with Applicant's prescription eyewear." Reply Br. at 4. Applicant maintains that registrant's goods are non-prescription

² The current Examining Attorney was not the original Examining Attorney in this case.

³ Registration No. 1,680,198 issued on March 24, 1992. Section 8 and 15 affidavits have been accepted or acknowledged respectively.

sunglasses and sunglass parts. Also, applicant argues that when the marks are viewed in their entirety, they are dissimilar.

We have considered the arguments and the evidence presented by the applicant and the Examining Attorney, and because we determine that there is a likelihood of confusion when the marks SHAPES and MICRO SHAPES are both used on sunglasses and other eyewear, we affirm the refusal to register the mark under Section 2(d) of the Trademark Act.

Determining whether there is a likelihood of confusion requires application of the factors set forth in In re E. I. du Pont de Nemours & Co., 476 F.2d 1357, 1361, 177 USPQ 563, 567 (CCPA 1973). In considering the evidence of record on these factors, we must keep in mind that "[t]he fundamental inquiry mandated by § 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks." Federated Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976).

We start by noting that both applicant and registrant use their marks on sunglasses. Applicant attempts to explain that the goods the marks are actually used on, the channels of trade, and conditions of sale are different.

Reply Br. at 4 - 12.⁴ However, both the application and the registration identify the goods, inter alia, simply as "sunglasses" without any restrictions or limitations. Therefore, we must consider that both applicant and registrant use the marks on the identical goods, sunglasses. See Octocom Systems, Inc. v. Houston Computers Services Inc., 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990) ("The authority is legion that the question of registrability of an applicant's mark must be decided on the basis of the identification of goods set forth in the application regardless of what the record may reveal as to the particular nature of an applicant's goods, the particular channels of trade or the class of purchasers to which the sales of goods are directed"). See also Paula Payne Products v. Johnson Publishing Co., 473 F.2d 901, 177 USPQ 76, 77 (CCPA 1973) ("Trademark cases involving the issue of likelihood of confusion must be decided on the basis of the respective descriptions of goods"); In re Dixie Restaurants, 105 F.3d 1405, 1406, 41 USPQ2d 1531, 1533 (Fed. Cir. 1997) (Applicant's restaurant services identified as "restaurant services specializing in

⁴ Applicant's Reply Brief contains statements about the registrant's goods that were not previously of record. We will not consider this "evidence" for the first time on appeal. 37 CFR § 2.142(d).

Southern-style cuisine" legally identical to registrant's restaurant services identified as "hotel, motel, and restaurant services"). We must presume that the goods move through all normal channels of trade for such products. Applicant's arguments that its goods are expensive, that they move through different channels of trade, and that they are sold differently is not persuasive because we are constrained to consider the issue of likelihood of confusion based on the goods identified in the application and registration. Nothing in these identifications of goods limits the goods to any specific channels of trade, purchasers, or type of sunglasses. In addition, applicant's eyeglasses are closely related to registrant's sunglasses. See Ex parte Kono Company, 73 USPQ 489, 490 (Comm'r Pat. 1947) (Applicant's goods [goggles and sunglasses and parts therefor] and those named in the registration [eyeglass and spectacle frames and parts therefore] are of substantially identical descriptive properties").

Next, we turn to the similarity of the marks. "If the services [or goods] are identical, 'the degree of similarity necessary to support a conclusion of likelihood of confusion declines.'" In re Dixie Restaurants, 105 F.3d 1405, 41 USPQ2d 1531, 1534 (Fed. Cir. 1997), quoting,

Century 21 Real Estate Corp. v. Century Life of America, 970 F.2d 874, 877, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992). The question here is whether the marks create the same commercial impression. The test is not whether the marks can be distinguished in a side-by-side comparison, but whether they are sufficiently similar in their overall commercial impression so that confusion as to the source of the goods marketed under the respective marks is likely to result. "[T]here is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of the mark, provided [that] the ultimate conclusion rests on consideration of the marks in their entireties." In re National Data Corp., 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985).

Here, both marks contain the identical word SHAPES in typed form. Applicant argues that by adding the word "MICRO" to "SHAPES," a different commercial impression is created. We disagree. Appropriating the entire registered mark and adding an additional term to it does not necessarily result in overcoming the likelihood of confusion. Wella Corp. v. California Concept Corp., 558 F.2d 1019, 1022, 194 USPQ 419, 422 (CCPA 1977)(CALIFORNIA CONCEPT and design held likely to be confused with CONCEPT for hair care products). In a similar case, the Board

determined that there was a likelihood of confusion when the mark EDEN was registered for wine and the applicant applied to register the mark MT. EDEN VINEYARDS for the identical goods. In re McWilliams, 200 USPQ 47, 49 (TTAB 1978) ("While there may be a different connotation between the terms 'EDEN' and 'MT. EDEN' insofar as the word 'EDEN' might be interpreted as referring to the Biblical 'Garden of Eden,' whereas 'MT. EDEN' would refer to a particular mountain, we do not believe that such difference in meaning between the respective terms would have any significant bearing upon the minds of prospective purchasers of wine insofar as the commercial impression created by such terms are concerned"); Corporate Fitness Programs, Inc. v. Weider Health & Fitness Inc., 2 USPQ2d 1682, 1690 (TTAB 1987) (SHAPE for magazines so resembles SHAPE WRITE UP and design for newsletters that confusion is likely).

Even if the overlapping terms in the marks consisted of descriptive and highly suggestive terms, it does not mean that these words would not be the dominant part of the mark. In re National Data Corporation, 753 F.2d 1056, 224 USPQ 749, 752 (Fed. Cir. 1985) ("Assuming CASH MANAGEMENT is generic or at least highly descriptive in both marks, as urged by National, does not, however, lead to a reversal in this case." CASH MANAGEMENT EXCHANGE held confusingly

similar to CASH MANAGEMENT ACCOUNT). Even though applicant has disclaimed the word "shapes," the term is not disclaimed in the cited registration nor is it registered under the provisions of Section 2(f) of the Trademark Act.

The Examining Attorney has noted that the term "micro" is defined as meaning "small." *American Heritage Dictionary of the English Language* (1992). The Examining Attorney argues that MICRO SHAPES "suggests that applicant's goods are small." Examining Attorney's Br. at 8. We agree that when the marks MICRO SHAPES and SHAPES are both used on sunglasses, they do not create different commercial impressions. Rather, prospective purchasers familiar with registrant's mark would likely believe that the same goods with applicant's mark would be simply a smaller version of registrant's goods. Even if we were to assume that purchasers of sunglasses and eyeglasses are sophisticated purchasers, they would likely be confused when marks as similar as applicant's and registrant's are used on the identical and closely related goods. Octocom Systems, 16 USPQ2d at 1787.

Marks do not have to be identical to be confusingly similar. Canadian Imperial Bank of Commerce v. Wells Fargo Bank, 811 F.2d 1490, 1 USPQ2d 1813, 1816-17 (Fed. Cir. 1987) (Marks "Commcash" and "Communicash" not identical but

strikingly similar). The only difference between applicant's and registrant's mark is the presence of the word "micro." The addition of this term does not result in the marks being significantly different in sound, appearance, or meaning.

Applicant also included with its appeal brief a list of applications and registrations, (Ex. B) which it says shows that the mark "Shapes is a weak mark."⁵ Applicant's Br. at 5. The Examining Attorney objects to the submission of this new evidence on appeal. Examining Attorney's Br. at 9. We agree. Applicant cannot introduce new evidence on appeal. 37 CFR § 2.142(d). In addition, we do not take judicial notice of registrations and applications in the Office nor, even if timely submitted, is it sufficient to simply include a list of marks with registration and application numbers to prove that a mark is weak. In re Hub Distributing, Inc., 218 USPQ 284, 285 (TTAB 1983) ("[W]e do not consider a copy of a search report to be credible evidence of the existence of the registrations and the uses listed therein"); See also In re Smith and Mehaffey, 31 USPQ2d 1531, 1532 (TTAB 1994); In re Duofold, Inc., 184 USPQ 638, 640 (TTAB 1974).

⁵ Applicant requests that if we do not consider these Office records, we should remand the application for further

Finally, applicant argues that registrant's mark is not famous, that there has been no actual confusion, and that applicant has "virtually no right to exclude others from use of the term SHAPES since it is 'descriptive' according to the examiner." Reply Br. at 22. First, an applicant cannot attack the validity of a registration in an ex parte proceeding. Dixie Restaurants, 41 USPQ2d at 1534. Second, it is unnecessary to show actual confusion in establishing likelihood of confusion. Giant Food, Inc. v. Nation's Foodservice, Inc., 710 F.2d 1565, 218 USPQ 390, 396 (Fed. Cir. 1983); J & J Smack Foods Corp. v. McDonald's Corp., 932 F.2d 1460, 18 USPQ2d 1889, 1892 (Fed. Cir. 1991). Moreover, an ex parte proceeding provides no opportunity for the registrant to show instances of actual confusion. Thus, even if the statement of applicant's attorney was supported by evidence of record, it would not eliminate the likelihood of confusion. Third, even if registrant's mark were weak, that would not mean that applicant's mark, which is used on the identical and closely related goods, would be registrable. The Court of Customs and Patent Appeals rejected the argument that marks on the Supplemental Register can only be used to refuse

examination. Reply Br. at 3. Applicant's request is manifestly untimely, and it is denied.

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registration for identical marks. In re The Clorox Co.,
578 F.2d 305, 198 USPQ 337, 341 (CCPA 1978). Here, the
registration is on the Principal Register, and there is no
reason to limit the scope of protection to identical marks.

Inasmuch as the goods are identical and closely
related and the marks create the similar commercial
impressions, there is a likelihood of confusion.

Decision: The refusal to register the mark under Section
2(d) is affirmed.